

**REMARKS**

Applicants respectfully traverse and request reconsideration.

Claims 1-31 have been cancelled without prejudice. Applicants reserve the right to reintroduce the subject matter previously presented in cancelled claims 1-31 in any new claims or in any pending claims. New claims 32-63 have been added. Applicants believe that the subject matter presented in new claims 32-63 is similar in scope to that previously presented in claims 1-31 or has full support in the originally-filed application. Applicants believe FIG. 2 and ¶¶ 28-55, among other places in the originally-filed application, support these new claims.

Claims 1-31 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. 20040148506A1 to Prince ("Prince"). By the above amendment, claims 1-31 have been cancelled. New claims 32-63 are pending in the current application.

Prince is directed to a method and apparatus for a non-revealing do-not-contact list system. Prince teaches that "the non-revealing do-not-contact list provides notice to entities to not send communications to entries on the non-revealing do-not-contact list without revealing the identities of the devices, their addresses, user accounts, contact numbers, etc." (¶29). To accomplish this, Prince appears to teach that a Master Do-Not-Contact ("DNC") list server 300 is responsible for collecting and storing hashed e-mail addresses, by way of a one-way hash engine and a Data Collecting System (element 100), for individuals that wish not to be contacted. (FIG. 1; ¶30). The Master DNC list server 300 appears to be communicable with a Client by way of software termed "Client Applications" or "Client Do-Not-Contact List Applications 400" executing on the Client or a Client-related computer. These Clients "send unsolicited communications or otherwise store or use contact information." Periodically, the Client (and the Client Application 400) contacts the Master DNC list server 300 for a copy of the Master DNC list which is stored by the Client locally as a Client DNC list. (¶33).

Prince further appears to teach that when the Client wishes to check the DNC list by comparing it to a list of entries (presumably e-mail addresses), it uses this local Client DNC list. (¶¶33, 36, 39; FIG. 4). In one embodiment, the Client DNC List Application 400 is hosted remotely from the Client. (¶39; FIG. 4). The Client passes the list of e-mail address to the Client DNC List Application 400, where it is hashed upon (i.e., after) receipt by the Client DNC List Application and compared to the entries in the Client DNC List. (¶39; FIG. 4). "In one embodiment, the remote Client Do-Not-Contact Application returns all the Client entries which do not appear on the Client Do-Not-Contact List in the form of a file. In an alternative embodiment, the remote Client Do-Not-Contact Application returns all the Client entries appear on the Client Do-Not-Contact List." (¶39; FIG. 4).

In other words, Prince does not appear to teach, suggest or even contemplate using three entities or computers where each entity/computer is responsible for sending and/or encoding e-mail addresses. For at least these reasons and for those that are articulated below with respect to the claims, Prince is not believed to be an anticipatory reference.

#### CLAIM 32, 41, 48, 52 & 58

Claim 32 presents a method of sending e-mail messages to a plurality of e-mail addresses wherein the method includes, among other things, three entities: a first, second and third entity. The third entity receives a first and second set of encoded e-mail addresses from the first and second entities, respectively, wherein each set of encoded e-mail addresses is encoded using an encoding algorithm. The first set of encoded e-mail addresses represents e-mail addresses to which an e-mail message could be sent. The second set of encoded e-mail addresses represents e-mail addresses to which an e-mail message should not be sent. The third entity also encodes a third set of encoded e-mail addresses using the same algorithm wherein the third set of encoded

e-mail addresses also represents e-mail addresses to which an e-mail message should not be sent. Prince does not appear to teach these limitations.

At best, Prince teaches that the Client Application, a piece of software, may execute on a computer remote to the Client. (§39). The Client Application executing on its related computer receives a hashed list of e-mail addresses associated with a master DNC list from a Master DNC list server (element 300 of FIG. 1, ¶[30, 33]). However, while the claims require a third entity to receive the first set of encoded e-mail addresses (representing e-mail addresses to which an e-mail message could be sent) and the second set of encoded e-mail addresses from a second entity (representing e-mail address to which the message should not be sent) in addition to the third entity encoding the third set of encoded e-mail addresses (also representing e-mail address to which the message should not be sent), Prince appears to teach that the Client Application does not receive any other hashed lists from any other entity or computer. At best, Prince appears to teach that the Client Application receives unhashed e-mail addresses from a client by means of a transfer and hashes them “one-by-one” before it “checks each hashed entry against the [local] Client Do-Not-Contact List.” (§39). For this reason alone, claim 32 appears to be in condition for allowance.

Claim 32 further requires “generating, by said third entity, a fourth set of encoded e-mail e-mail addresses” based on the first, second and third sets of encoded e-mail addresses. Because Prince does not appear to teach receiving a first and second set of encoded e-mail addresses by a third entity in addition to the third entity encoding a third set of e-mail addresses into a third-set of encoded e-mail addresses, the claim is properly allowable over the cited prior art.

Claim 48 has the same or similar limitations and are therefore believed to be in proper condition for allowance for at least the same reasons as articulated above.

Claims 41, 52 and 58 also contain the same or similar limitations as claim 32. Applicants further note that claims 41, 52 and 58 further require the following limitations which are also not found by Applicants in Prince:

- sending, by a third entity, to each of a first entity and a second entity an encoding algorithm...
- encoding by a first entity using said encoding algorithm a first set of e-mail address to which an e-mail message could be sent;
- encoding by a second entity using said encoding algorithm a second set of e-mail address to which an e-mail message should not be sent;
- encoding by said third entity using said encoding algorithm a third set of e-mail address to which an e-mail message should not be sent;

Because Prince does not teach or suggest these limitations in addition other similar to those discussed above, these claims are believed to be in proper condition for allowance for the same or similar reasons.

If the Examiner is of a different opinion with respect to Applicants' remarks presented above, Applicants' kindly ask the Examiner to provide a specific citation by paragraph number and/or column and line number to Prince or other prior art that allegedly teaches each and every limitation in Applicants' claims.

#### DEPENDENT CLAIMS


The pending dependent claims are each dependent upon an allowable base claim. Applicants further believe these claims to add additional novel, non-obvious and patentable subject matter that is not otherwise taught or suggested in the cited prior art. For these reasons and for those articulated above, these dependent claims are also believed to be in proper condition for allowance.

Applicants respectfully submit that the claims are in condition for allowance and respectfully request that a timely Notice of Allowance be issued in this case. The Examiner is

invited to contact the below listed attorney if the Examiner believes that a telephone conference will advance the prosecution of this application.

Respectfully submitted,

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